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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/995,374	Applicant(s) O'BRIEN ET AL.	
	Examiner CLEMENT B. GRAHAM	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/28/03, 5/20/04, 5/25/05, 11/26/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-19 remained pending

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 9, 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claims recites "selecting", "identifying" and "invoking", however these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 9, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, Claims 1, 9, 19, recite the words ["asset characteristic"].

However this language fails to distinctly claim Applicant's invention because the scope of the claim is unclear. Moreover the specification fails to clarify, the meaning of the limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3692

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao 6, 347, 302 in view of Bond US Patent No: 6, 738, 736.

As per claim 1, Joao, discloses a method for benchmarking data relating to an asset, comprising the steps of selecting a group of assets that are included in the pool of benchmarking information on a computer.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

Joao fail to explicitly teach identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information; and invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic;

wherein at least two, organizations contribute to the pool of benchmarking information.

However Bond discloses in an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a capability development function, (5) a change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include teach identifying on a

computer an asset characteristic relating to an asset included in the pool of benchmarking information and invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic;

wherein at least two, organizations contribute to the pool of benchmarking information taught by Bond in order to provide an estimate for building a capacity modeling and planning function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

As per claim 2, Joao, discloses a wherein the selected group of assets are selected on the basis of a shared asset characteristic. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 3, Joao, discloses further comprising comparing the benchmark value to a characteristic of a target asset. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 4, Joao, discloses wherein the pool of benchmarking information and the benchmark value are stored on a database. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 5, Joao, discloses wherein at least two non-related organizations contribute to the pool of benchmarking information.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 6, Joao, discloses wherein the benchmark value is cost information relating to the asset. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 7, Joao, discloses wherein organizationally identifiable information is not accessible to a end-user.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 8, Joao, discloses wherein an end-user in one organization cannot view organizationally identifiable information belonging to a different organization.

As per claim 9, Joao, discloses a system for benchmarking data relating to an asset, comprising:

a plurality of assets including an asset characteristic and a data value for said asset characteristic and a plurality of organizations with relationships to said plurality of assets.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

Joao fail to explicitly teach benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations; and a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool.

However Bond discloses In an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a capability development function, (5) a change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations; and a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool taught by Bond in order to provide an estimate for building a capacity modeling and planning

function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

As per claim 10, Joao, discloses a system for benchmarking data relating to an asset as in claim 9, wherein said plurality of organizations include at least two unrelated organizations. (see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 11, Joao, discloses said benchmarking information pool including a plurality of organizationally identifiable data, wherein said plurality of organizationally identifiable data is hidden from said benchmarking information pool before the application of said benchmarking heuristic.

As per claim 12, Joao, discloses wherein said plurality of organizationally identifiable data is hidden from said plurality of organizations.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 13, Joao, discloses wherein said benchmark value is a monetary amount.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 14, Joao, discloses said plurality of assets including a first asset characteristic, a second asset characteristic and a larger plurality of assets.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67) wherein said plurality of assets are a subset of said larger plurality of assets; wherein said first asset characteristic is included in said benchmarking information pool; and wherein said plurality of assets are selective identified from said larger plurality of assets on the basis of said second asset characteristic.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 15, Joao, discloses wherein said second asset characteristic is not included in said benchmarking information pool.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 16, Joao, discloses further comprising a target asset including said asset characteristic and a target value, wherein said system automatically compares said target value to said benchmark value. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 17, Joao, discloses further comprising a database, wherein said pool of benchmarking information is stored on a database. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 18, Joao, discloses further comprising a plurality of asset values and a plurality of benchmark values, wherein said benchmark heuristic generates said plurality of benchmark values from said plurality of asset values. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 19, Joao, discloses a system for benchmarking data relating to an asset, comprising:
a plurality of assets, including a subset of selected assets, wherein each asset in said plurality of assets includes a plurality of asset characteristics and wherein each said asset characteristic has a data value.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67)

Joao, fail to explicitly teach a plurality of organizationally identifiable data, including a subset of said asset characteristics and said data value relating to said asset characteristics, a plurality of unrelated organizations with relationships to said plurality of assets, a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations, and a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool.

However Bond discloses In an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a capability development function, (5) a

change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include a plurality of organizationally identifiable data, including a subset of said asset characteristics and said data value relating to said asset characteristics, a plurality of unrelated organizations with relationships to said plurality of assets, a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations, and a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool taught Bond in order to provide an estimate for building a capacity modeling and planning function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

Conclusion

RESPONSE TO ARGUMENTS

7. Applicant's arguments filed 3/13/08 has been fully considered but there are not persuasive for the following reasons.
8. In response to Applicant's as it pertains to Joao and Bond.
9. Applicant's claims 1, 9, 19, states "a benchmark heuristic to generate a benchmark"

However the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

**>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and ambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed.

Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

10. Applicant also maintains that Joao and Bond cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law. Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

11. In response to applicant's argument that Bond is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the primary reference, Joao clearly teaches a method for benchmarking data relating to an asset, comprising the steps of selecting a group of assets that are included in the pool of benchmarking information on a computer. Furthermore, the Examiner asserts that there are different types asset characteristic relating to an asset included in the pool of benchmarking information. An would have the designer choice, further asset characteristic is also well known in the art of identifying assets. The Examiner has turned to Bond to show this well known teaching. It is clearly noted that Bond clearly teaches in an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. Thus one of ordinary skill in the art would have been motivated in an IT enterprise, multiple functions may be

organized and categorized. Thus, Joao and Bond are analogous art in the manner that both references attempt to solve the same problem by identifying on a computer an asset characteristic relating to an asset.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLEMENT B. GRAHAM whose telephone number is (571)272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3692

CG

June 20, 2008